

IV. Amendments to the Drawings:

New sheets 2, 3 and 4 of the drawings are attached that include changes to Figs 3, 4A, 4B and 5. These sheets replace previous sheets 2, 3 and 4 and include the addition of reference numeral 28 to Figs. 3, 4A and 4B as required by the examiner and some changes to the reference numerals in Fig. 5 consistent with the above changes to the specification. Annotated drawings sheets 2, 3 and 4 are also attached indicating the changes.

V. Remarks

The original claims 1-31 have been cancelled in favor of new claims 32-39

The original cancelled claims 1-31 were rejected as being anticipated and unpatentable over the Carlson (U.S. 2,091,628). However, Carlson does not anticipate nor render unpatentable new independent claim 32 since Carlson does not teach a surgical cutting tool comprising tubular housing having a bore and at least one slot formed through its wall; a cutting blade adapted to move relative to the slot and having an inner portion extending in each slot and an outer portion projecting from the slot; the outer portion of each blade having a continuous cutting edge; the inner edge of each blade having a plurality of spaced straight portions, a series of spaced stepped portions each extending between two straight portions, and a series of tapered surfaces respectively extending from the stepped portions; an actuator rod disposed in the bore and having a plurality of spaced straight portions and a plurality of spaced conical surfaces each extending between two straight portions; and the straight portions of the blade being aligned with the respective straight portions of the rod, and the tapered surfaces of the blade engaging the respective conical surfaces of the rod so that axial movement of the actuator rod in the bore causes radial movement of each blade relative to its respective slot to vary the size of the cut.

Rather, as admitted by the examiner at page 7 of the office action:

Carlson does not disclose a plurality of axially-spaced surfaces formed on the actuator and a plurality of axially-spaced surfaces formed on the blade.

The PTO provides in MPEP §2131 that:

"[t]o anticipate a claim, the reference must teach every element of the claim."

Therefore, to support these rejections with respect to new claim 32, the Carlson patent must contain all of the above-claimed elements of the claim. However, as admitted by the examiner, this is not the case. Therefore, the previous rejections based on 35 U.S.C. §102(b) cannot be supported by the Carlson patent as applied to new claim 32.

Some of the previous claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Carlson. However, this rejection is not applicable to new claim 32 for the following reasons.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

The examiner clearly cannot establish a *prima facie* case of obviousness in connection with claim 32 since 35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Carlson, does not render new independent claim 32 unpatentable since Carlson does not teach the combination of claim 32, namely, a surgical cutting tool comprising tubular housing having a bore and at least one slot formed through its wall; a cutting blade adapted to move relative to the slot and having an inner portion extending in each slot and an outer portion projecting from the slot; the outer portion of each blade having a continuous cutting edge; the inner edge of each blade having a plurality of spaced straight portions, a series of spaced stepped portions each extending between two straight portions, and a series of tapered surfaces respectively extending from the stepped portions; an actuator rod disposed in the bore and having a plurality of spaced straight portions and a plurality of spaced conical surfaces each extending between two straight portions; and the straight portions of the blade being aligned with the respective straight portions of the rod, and the tapered surfaces of the blade engaging the respective conical surfaces of the rod so that axial movement of the actuator rod in the bore causes radial movement of each blade relative to its respective slot to vary the size of the cut.

Although Carlson suggests, at page 2, column 1, lines 68-71, the possibility of a plurality of axially spaced blades, this is a far cry from the above combination of claim 32 that does not deal with axially spaced blades.

Thus, in the unique arrangement of claim 32, applicants have eliminated the need for a plurality of axially spaced blades. Therefore, it is impossible to render the subject matter of claim 32 as a whole obvious based on Carlson and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of

obviousness clearly cannot be met with respect to claim 32, and a rejection under 35 U.S.C. §103(a) is not applicable.

Dependent claims 33-39 depend from, and further limit, independent claim 32 in a patentable sense and therefore are also allowable.

Attached are replacement sheets of formal drawings which include the changes requested by the Examiner. Also attached are 3 annotated drawing sheets.

A Substitute Specification is attached which includes the correct paragraph numbering and the amendments made to the specification.

In view of all of the above, the allowance of claims 32-39 is respectfully requested.

The examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

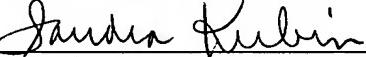

Warren B. Kice

Registration No. 22,732

Dated: 11/9/06
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 214/651-5634
Fax: 214-200-0853

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on November 9, 2006


Signature of person mailing paper and fee

SANDRA KUBIN